



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,494	01/30/2004	Achim Melching	87333.3321	5036
7590 07/11/2008 BAKER & HOSTETTLER LLP Suite 1100 Washington Square 1050 Connecticut Avenue, N.W. Washington, DC 20036				
EXAMINER				
RAMDHIANE, BOBBY				
ART UNIT		PAPER NUMBER		
1797				
MAIL DATE		DELIVERY MODE		
07/11/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/767,494

Applicant(s)

MELCHING ET AL.

Examiner

BOBBY RAMDHANIE

Art Unit

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed on 03/06/2008 have been fully considered but they are not persuasive. The following reasons are why:
2. For Claim 1; In response to applicant's argument that Malin does not disclose the possibility of storing the specimen in the buffer storage device, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.
3. Applicants' argue that the Malin does not disclose a plurality of storage locations in the automatic conveyor system. Examiner respectfully disagrees. The plurality of storage locations must be inherent because Malin discloses that the automatic conveyor system is for "objects" – emphasis on the plurality of the objects. Based on the reasonable interpretation of this disclosure it would be essential that the automatic conveyor system contain a plurality of storage locations.
4. For Claim 11, Applicants argue that Malin does not disclose pre-air conditioning of the outer transfer device. Examiner respectfully disagrees. Claim 11 is to a device which is capable of pre-air conditioning the buffer storage device. Malin discloses such a device. Claim 11 is not drafted sufficiently to interpret that a separate device is located in the buffer storage device for pre-air conditioning the buffer storage device.

5. Applicants' argue that Helwig does not disclose a plurality of specimen storage spaces in an external buffer storage system like the present invention. Examiner believes that the device does not have to look the same, to anticipate or be rendered obvious on the applicants' invention.

6. Applicants' argue that the Examiner possesses an ex-post-facto perspective. Examiner respectfully disagrees. One of ordinary skill in the art would indeed combine the two references since Milan discloses that the buffer storage device may comprise an automatic conveyor system. Helwig discloses such a system; and both Helwig and Milan disclose the same problem, limiting the large amount of climatic fluctuations experienced in the use of climatic cabinets (See Column 3 lines 7-18).

Response to Amendment

Claim Objections

7. Claims 14 & 15 are objected to because of the following informalities: The claims have the same limitations repeated within the claim. Appropriate correction is required.

8. Claim 10 is objected to because of the following informalities: The claim recites a "bugger." This should be corrected to "buffer." Appropriate correction is required.

Claim Rejections - 35 USC § 112

9. Claims 1 and 3-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter

Art Unit: 1797

which applicant regards as the invention. It is unclear how a door makes a conscious decision to accommodate access to a utilization space.

10. Claims 1 and 3-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear what type of structural relationship is being described between the at least one transfer and at least one transfer opening with the at least one specimen storage device

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. Claims 1, 3-7, 9-18, & 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Milan in view of Helwig et al.

14. Applicants' claims are toward a cabinet.

15. Regarding Claims 1, 3-7, 9-18, & 20, Milan discloses the climatic cabinet, comprising: A). A door (See Figure 1a, Item 210) accommodating access to a utilization space (See Figure 1a Item 2); B). At least one specimen storage device accessible through the door and utilization space (See Figure 1b Item 650); C). At least one inner transport device (See Figure 1b Item 620) and at least one transfer opening with the at least one specimen storage device (See Figure 1a Items 210 & 220 (front opening) & See Figure 4b Item 15 (back door opening); and D). A buffer specimen storage device (See Figure 5a Item 100) and an outer transport device (See [0083]) are arranged outside the transfer opening (See Figure 5a) and that the outer transport device establishes a transport connection between the buffer specimen storage device and the transfer opening by which a specimen can be moved between the buffer specimen storage device and the inner transport device (See Figure 4a). Malin does not explicitly disclose that the buffer specimen storage device comprises a plurality of specimen storage locations. Malin does however disclose that the buffer storage device may comprise an automatic conveyor system which is used with a plurality of specimens (See [0083]). Helwig discloses a buffer specimen storage device which comprises an automatic conveyor system which comprises a plurality of specimen storage locations (See Figure 3a in view of Figure 7). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the buffer storage device of Malin with the explicitly taught storage station of Helwig which explicitly discloses a plurality of specimen locations simply because has an automatic conveyor system.

Additional Disclosures Included: Claim 3: Wherein the buffer specimen storage device is designed as a separate unit that can be detachably connected via a coupling device to the climatic cabinet (See Malin Figure 5a Items 151 & 152); Claim 4: Wherein the buffer specimen storage device comprises at least one specimen slide cassette (See Helwig et al Figure 7 Item 15); Claim 5: The climatic cabinet according to Claim 3, wherein the buffer specimen storage device comprises several specimen storage cassettes in a carousel arrangement (See Helwig et al Figure 2 Items 15); Claim 6: Wherein the outer transport device comprises a vertically movable lift and a horizontally movable shifting unit (See Helwig et al Figure 7 Item 11); Claim 7: Wherein the transfer location for a specimen is located between the outer and the inner transport device in the area of the transfer opening (See Figure 4a & [0072]); Claim 9: Wherein the buffer specimen storage device and the outer transport device are arranged in a housing with a service opening (See Helwig et al Figure 1 Item 1); Claim 10: A buffer specimen storage device with an outer transport device and housing for use with a climatic cabinet according to Claim 9 (See Rejection for Claim 9), wherein the buffer specimen storage device is designed as a separate unit that can be detachably connected to the climatic cabinet via a coupling device (See Malin Figure 5a Items 151 & 152); Claim 11: Wherein a device is present for the pre-air-conditioning of the buffer specimen storage device and/or of the outer transport device (See Malin Figure 6b Item 642); Claim 12: Wherein the device for pre-air-conditioning is designed as a blower (See Malin Figure 6b Item 642); Claim 13: Wherein the device for pre-air-conditioning is controlled as a function of an actuation of the service opening (See Malin [0094]) & Figure 4b & 6b); Claim 14: A climatic cabinet,

comprising: A). A door (See Malin Figure 1a, Item 210) accommodating access to a utilization space (See Malin Figure 1b Item 650); at least one specimen storage device accessible through the door and utilization space (See Malin Figure 1b Item 650); at least one inner transport device (See Malin Figure 1b Item 620) and at least one transfer opening with the at least one specimen storage device (See Malin Figure 1a Items 210 & 220 (front opening) & See Figure 4b Item 15 (back door opening); and a buffer specimen storage device (See Malin Figure 5a Item 100) and an outer transport device are arranged outside the transfer opening and that the outer transport device establishes a transport connection between the buffer specimen storage device and the transfer opening by which a specimen can be moved between the buffer specimen storage device and the inner transport device (See Malin [0083]); with the buffer specimen storage device comprising a plurality of specimen storage locations (See Malin Figure 3a in view of Figure 7), the buffer specimen storage device comprises a plurality of specimen storage locations (See Malin Figure 3a in view of Figure 7), a device is present for the pre-air-conditioning of the buffer specimen storage device and/or of the outer transport device (See Malin Figure 6b Item 642); Claim 15: A climatic cabinet, comprising: A). A door means (See Malin Figure 1a, Item 210) accommodating access to a utilization space(See Malin Figure 1b Item 650); B). A specimen storage means accessible through the door and utilization space (See Malin Figure 1a Item 650); C). An inner transport means (See Malin Figure 1b Item 620) and at least one transfer opening with the specimen storage means (See Malin Figure 1a Items 210 & 220 (front opening) & See Figure 4b Item 15 (back door opening); and D). A buffer

Art Unit: 1797

specimen storage means (See Malin Figure 5a Item 100) and an outer transport means are arranged outside the transfer opening and that the outer transport device establishes a transport connection between the buffer specimen storage device and the transfer opening by which a specimen can be moved between the buffer specimen storage device and the inner transport device (See Malin [0083]) with the buffer specimen storage device comprising a plurality of specimen storage locations See Malin Figure 3a in view of Figure 7), a device is present for the pre-air-conditioning of the buffer specimen storage device and/or of the outer transport device (See Malin Figure 6b Item 642); a device is present for the pre-air-conditioning of the buffer specimen storage device and/or of the outer transport device (See Malin Figure 6b Item 642); Claim 16: The climatic cabinet according to Claim 15, wherein the buffer specimen storage means comprises a plurality of specimen storage locations (See Helwig et al Figure 3a in view of Figure 7); and the buffer specimen storage means for use with a climatic cabinet includes as a separate unit that can be detachably connected via a coupling means to the climatic cabinet (See Malin Figure 5a Items 151 & 152); Claim 17: The climatic cabinet according to Claim 15, wherein the buffer specimen storage means comprises at least one specimen slide cassette (See Helwig et al Figure 7 Item 15), and the buffer specimen storage device comprises several specimen storage cassettes in a carousel arrangement (See Helwig et al Figure 7); Claim 18: Wherein the outer transport means comprises a vertically movable lift and a horizontally movable shifting unit, and the transfer location for a specimen is located between the outer and the inner transport means in the area of the transfer opening (See Helwig et al Figure 7

Art Unit: 1797

Item 11); Claim 20: The climatic cabinet according to claim 15, further comprising a buffer specimen storage device with an outer transport device and housing for use with a climatic cabinet is included as a separate unit that can be detachably connected to the climatic cabinet via a coupling device (See Malin Figure 5a Items 151 & 152).

Double Patenting

16. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1 and 3-20 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 & 2 of U.S. Patent No. 7013197. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following:

2. Independent Claims 1, 14, & 15, recite:

3. A climatic cabinet, comprising: a door accommodating access to a utilization space; at least one specimen storage device accessible through the door and utilization; at least one inner transport device and at least one transfer opening with the at least one specimen storage device, and a buffer specimen storage device and an outer transport device are arranged outside the transfer opening and that the outer transport device establishes a transport connection between the buffer specimen storage device and the transfer opening by which a specimen can be moved between the buffer specimen storage device and the inner transport device with the buffer specimen storage device comprising a plurality of specimen storage locations.

4. Claims 1 & 2 of Patent # 7013197 recites: Climatic cabinet with specimen storage places and a transporting device and a monitoring device for specimen slides, characterized in that the monitoring device is so designed, with regard to its shape and outside dimensions, in such a way that it can be transported by the transporting system and laid on one of the specimen storage places and can be removed from a specimen storage place.

Claim 2: Climatic cabinet according to claim 1, characterized in that a specimen storage place for the storage of the monitoring device is affixed to the outside of the climatic cabinet.

It would have been obvious for a climatic cabinet to have a door, to have a utilization space, and a transfer opening that is explicitly recited in the instant application.

Telephonic Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BOBBY RAMDHANIE whose telephone number is (571)270-3240. The examiner can normally be reached on Mon-Fri 8-5 (Alt Fri off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Walter Griffin can be reached on 571-272-1447. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Bobby Ramdhanie, Ph.D./
Examiner, Art Unit 1797
/B. R./

/Walter D. Griffin/
Supervisory Patent Examiner, Art Unit 1797